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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,869	09/21/2000	Thomas Vaughn Wilder	DAREDEV.018RA	4598

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EXAMINER

MAR, MICHAEL Y

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 07/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,869

Applicant(s)

Thomas V. Wilder et al

Examiner

Michael Mar

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Reissue Application

1. Applicant's offer to surrender the original patent is acknowledged. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

2. Claims 13 and 16-28 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

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Claim 5 of '369 patent recites: "one or more web members extending between". Reissued claim 13 recites: "at least one cross-member extending between". Recitations which included the recitation "one or more web members extending between" were added to claim 5 to overcome the rejection during the prosecution of the '369 patent. Since the term "cross-member" is considered broader than the term "web", the substitution of this term in the reissued claim would constitute recapture of subject matter previously surrendered.

Claim 5 of '369 patent recites: "in an upwardly extending direction above said one or more web member". Reissued claim 13 recites: "in an upwardly extending direction". Since the recitation "in an upwardly extending direction above said one or more web member" was added to claim 5 during the prosecution of the '369 patent, the omission of the portion "above said one or more web member" in the reissued claim would constitute recapture of subject matter previously surrendered.

Claim 5 of '369 patent recites in line 6: "a pair of laterally spaced longitudinal members". Reissued claim 13 recites in line 4: "a pair of elongate, spaced apart members". The recitation "laterally spaced" which was added to claim 5 during the prosecution of the '369 patent. Since the recitation "spaced apart" is considered broader than the term "laterally spaced", the substitution of this term in the reissued claim would constitute recapture of subject matter previously surrendered.

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Claim 5 of '369 patent recites: "one or more web members extending between". Reissued claim 22 recites: "at least one cross-member extending between". Recitations which included the recitation "one or more web members extending between" were added to claim 5 to overcome the rejection during the prosecution of the '369 patent. Since the term "cross-member" is considered broader than the term "web", the substitution of this term in the reissued claim would constitute recapture of subject matter previously surrendered.

3. The reissue oath/declaration filed with this application is defective because it fails to identify the errors in the '369 patent which are relied upon to support the reissue application with respect to claims 22-28 presented in the preliminary amendment filed April 30, 2001.

See 37 CFR 1.175(a)(1) and MPEP § 1414.

4. Claims 1-13 and 16-28 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

REMARKS

5. Applicant's remarks have been considered but are not deemed persuasive.

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In applicant's response filed March 16, 1998 in the application file of the '369 patent, applicant had stated on page 4 of the remarks with respect to claim 1, "Also, one or more connecting webs extend between the longitudinal members. Pellegrini does not disclose such structure." Applicant had also stated on page 4 of the remarks "Similarly, Applicant's Claim 2, as amended, requires a pair of longitudinal members having upper and lower portions separated by one or more web members which extend between the longitudinal members. The upper portions form substantially convergent planes above the web member and lower portions form substantially parallel planes below the web member. By this design, the chassis forms substantially an A-frame when viewed in cross section. Again, Pellegrini does not disclose such structure."

Because applicant had argued that the "webs" or the "web members" was a patentable limitation during the prosecution of the '369 patent in order to make the application claims allowable over a rejection made in the application, to change the term web to transverse member in the instant application would not only constitute a broadening of the claim but would also constitute an impermissible recapture. See MPEP 1412.03

While claims 13 and 22 may contain additional limitations which were not recited in independent claims 1 and 2 of the '369 patent, because the recitation of a web member was a critical limitation for determining the patentability of the claims in the '369 patent, the broadening of the term web member would still constitute an impermissible recapture.

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6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. **Any response to this action should be mailed to:**

Assistant Commissioner for Patents

Washington, D.C. 20231

or faxed to:

(703) 308-2571

(for formal communications intended be entered)

(all informal communications should be labeled "PROPOSED" OR "DRAFT")

or hand delivered to:

Crystal Park 5, 2451 Crystal Drive, Arlington, Virginia 22202

Seventh Floor(receptionist)

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8. Any inquiry concerning this communication should be directed to Michael Mar at telephone number (703) 308-2087 or by e-mail at: **michael.mar@uspto.gov**

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



MICHAEL MAR

Primary Examiner

M.Mar

June 28, 2002